



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|-------------------------------|------------------------|
| 10/541,210 | 06/30/2005 | Olivier Dupuis | 66345-0036 | 6344 |
| 25269 | 7590 | 09/07/2007 | | |
| DYKEMA GOSSETT PLLC FRANKLIN SQUARE, THIRD FLOOR WEST 1300 I STREET, NW WASHINGTON, DC 20005 | | | EXAMINER ABU ALI, SHUANGYI | |
| | | | ART UNIT 1755 | PAPER NUMBER |
| | | | MAIL DATE 09/07/2007 | DELIVERY MODE PAPER |

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|--------------------------------------|--------------------------------------|--|
| Office Action Summary | Application No. 10/541,210 | Applicant(s) DUPUIS ET AL. | |
| | Examiner Shuangyi Abu-Ali | Art Unit 1755 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 June 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 and 11-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 and 11-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

(1)

Status of Claims

Claims 1-9, 11-24 remain for examination wherein claim 1 is amended and claims 10 is canceled. Claim 25 is new.

(2)

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 1 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The insoluble acrylic polymer is a new matter.

(3)

Claim Rejections - 35 USC § 102

Claims 1-9, 11-13 and 15-21 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,685,898 to Dupuis et al. as general set forth in the first office action mailed on 12/19/2006 stands.

Claim Rejections - 35 USC § 103

Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over U. S. Patent No.5, 685,898 to Dupuis et al. in view of U.S. Patent No. 4,622,069 to Akai et al. as general set forth in the first office action mailed 12/19/2006 stands.

Claim 24 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No.5, 685,898 to Dupuis et al. in view of US 2004/0037978 A1 to Tsubaki et al. as general set forth in the first office action mailed 12/19/2006 stands.

Claims 22 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over U. S. Patent No.5, 685,898 to Dupuis et al. as general set forth in the first office action mailed 12/19/2006 stands.

The text of those sections of title 35 US Code not included in this action can be found in the prior Office Action.

(3)

Response to Amendment

Applicants' amendments to the specification, filed on 06/19/2007 are acknowledged.

(4)

Response to Arguments

Applicant's arguments filed 06/19/2007 have been fully considered but they are not persuasive. Therefore, the grounds of rejection for claims 1-9 and 11-24 as indicated in the first Office Action stand.

Art Unit: 1755

First, the applicant argues the primary prior art to Dupuis et al. uses water soluble acrylic polymer, and insoluble acrylic polymer used in the instant application . The Examiner respectfully submits insoluble polymer recited in claim 1 is a new matter. And also the solubility of polymers depends on what kind of the solvent used (such as water or organic solvent). The acrylic polymer Joncryl 537 used in the instant application is a water-soluble polymer (please see U.S. patent NO. 5,830,927, Table A).

Secondly, the applicant argue that the instant application use organic solvent other than methanol and ethanol in claim 1. The Examiner respectfully submits applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., the desired solvent system)are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Furthermore, combining teaching of Dupuis et al. and Akai et al. teach the solvent system claimed by the applicant.

(5)

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Art Unit: 1755

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claim 25 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. 5,264,466 to Takiyama et al., in view of U.S. Patent No.5, 685,898 to Dupuis et al.

Regarding claim 25, Takaiyama et al. disclose a composition comprising polymer and copper chloride (abstract and col. 5, line 65). But they are silent about the other ingredient as applicants set forth in claim 1.

However, it would have been obvious to one of ordinary skill in the art at the time of invention by applicant to use the other ingredients as applicants set forth in claim 1, motivated by the fact that Dupuis et al., also drawn to a coating composition, disclose that such dispersion is stable, and Ph and viscosity is adjustable (abstract).

Conclusion

1. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within

Art Unit: 1755

TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shuangyi Abu-Ali whose telephone number is 571-272-6453. The examiner can normally be reached on Monday - Friday.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry Lorengo can be reached on 571-272-1233. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Application/Control Number: 10/541,210
Art Unit: 1755

Page 7

sa


J. A. LORENGO
SUPERVISORY PATENT EXAMINER